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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,162	09/27/2001	Steve E. Hoffman	9436-9	3930

23973 7590 11/14/2003

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EXAMINER	
WINDMULLER, JOHN	
ART UNIT	**PAPER NUMBER**
3724	11

DATE MAILED: 11/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/965,162	HOFFMAN, STEVE E.	
	Examiner	Art Unit	
	John Windmuller	3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 August 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. The amendment filed 8/8/03 has been entered.

2. Examiner acknowledges that the election of group II, claims 1-6, 13-18 was made with traverse, not without traverse as noted in the previous office action.

Response to Arguments

3. On page 5 of Applicant's remarks, Applicant states that method claims 7-12 have been amended to recite a method of making a product with the surface finish recited in claims 1 and 13 and requests that the restriction of method claims 7-12 be reconsidered. The method claims remain restricted, since to merely state that the method will achieve a certain result does not mean that it cannot be used to achieve a different result.

4. On page 6 of Applicant's remarks, Applicant addresses the product-by-process formulation of claims 1 and 13. The amendment to claims 1 and 13 is not sufficient to overcome the rejection of claims 1, 2, 6, 13, 14, 18 under 35 U.S.C. 102(b). By the amendment, claims 1 and 13 are now product-by-process claims. According to MPEP § 2113, rejection of product-by-process claims under 35 U.S.C. 102 is proper because " '...when the prior art discloses a product which reasonably appears to be either identical with or only slightly different from a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped

to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith.' *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972)." Therefore, the rejection is proper.

5. On pages 6-7, Applicant states that claims 2 and 14 read on Vankov because Vankov does not disclose a saw blade including a cutting tip with a width substantially equal to the width of the blade portion. However, the teeth 7 of Vankov may be considered cutting tips and are equal in width or thickness to the main portion of the blade, so the rejection stands.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 2, 6, 13, 14, 18 are rejected under 35 U.S.C. 102(b) as being unpatentable over Vankov et al. The device of Vankov et al. discloses the invention as claimed, including, inter alia, a straight blade portion with a plurality of teeth and two opposed sides which define a blade portion width, having a surface finish which is less than approximately 10 Ra (col. 5, lines 56-61; col. 6, lines 14-18; col. 10, lines 33-45), having a surface finish which is approximately 6 Ra or less (col. 6, lines 14-18), the sides of the teeth having a surface finish less than 10 Ra and less than 6 Ra (col. 5, line

65 through col. 6, line 3), a cutting edge and teeth having a cutting tips width that are substantially the same as the blade portion width.

Claims 1 and 13 have been amended to include method steps, making them product-by-process claims. For the reasons stated in paragraph 4 above, the method steps have not been given weight.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 3, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vankov et al. in view of Gakhar et al. The device of Vankov et al. discloses the invention as claimed except for an anti-kickback portion coated with a low friction surface located behind each cutting tip. However, Gakhar et al. teach an anti-kickback portion coated with a low friction surface located behind each cutting tip (Fig. 43, item 14; col. 4, line 67; claim 3). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the device of Vankov et al. with an anti-kickback portion coated with a low friction surface located behind each cutting tip as taught by Gakhar et al. for less blade binding.

10. Claims 4, 5, 16, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vankov et al. The device of Vankov et al. discloses the invention as claimed except for the surface finish of the blade portion and the sides of the teeth being in a range of between approximately 2 Ra and 6 Ra and in a range of between approximately 2 Ra and 4 Ra. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a surface finish in the ranges specified for better blade performance, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Windmuller whose telephone number is 703 305-4988. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 703 308-1082. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-1148.

jw

Allan N. Shoap
Supervisory Patent Examiner
Group 3700